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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92057220
Party	Plaintiff Motion Fitness
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Submission	Opposition/Response to Motion
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Date	07/31/2013
Attachments	Opposition to Motion to Dismiss.pdf(158582 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**The Trademark Trial and Appeal Board**

In the matter of U.S. Registration 3,875,390  
For the mark EXERGAME ZONE KIDS ACTIVITY ARCADE WHERE KIDS GET FIT!  
WWW.EXERGAMEZONE.COM (and Design)  
Registered on the Principal Register on November 16, 2010

Motion Fitness	:	
	:	
Petitioner,	:	
	:	
vs.	:	Cancellation No. 92057220
	:	
Jonathan Jarashow,	:	
	:	
Registrant.	:	

**OPPOSITION TO MOTION TO DISMISS**

Petitioner, Motion Fitness (hereinafter “Petitioner”), by counsel, hereby files the instant *Opposition to Motion to Dismiss* opposing Registrant Jonathan Jarashow’s (hereinafter “Registrant”) *Motion to Dismiss* filed on or about June 26, 2013. On the grounds as more fully set forth below Petitioner requests that the instant *Motion to Dismiss* denied.

**STATEMENT OF THE CASE**

On or about May 8, 2013 Petitioner filed the instant *Petition to Cancel* the subject registration. The *Petition to Cancel* listed one grounds as the basis for the petition: abandonment of the subject registration without the intent to resume use.

On or about June 26, 2013 Registrant filed its *Motion to Dismiss the Petition to Cancel* pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure and Section 503.02 of the Trademark Trial and Appeal Board Manual of Procedure. In its motion, or the *Certification* which accompanied the motion, Registrant listed only one grounds for its Rule 12(b)(6) motion to be granted: its mark is still in use. *See Certification of Registrant*. The evidence of use

provided in support of this motion was, once again, the Certification of the Registrant dealing with facts outside of the instant pleadings.

## **ARGUMENT**

### ***Registrant's Motion Should be Treated as a Premature Motion for Summary Judgment***

The Board will treat a motion to dismiss relying on matters outside the pleadings as a motion for summary judgment. *See* TBMP § 503.04. *See also Stephen Slesinger Inc., v. Disney Enterprises Inc.*, 98 USPQ2d 1890, 1894 (TTAB 2011) (motion to dismiss treated as one for summary judgment because matters outside the pleadings considered); *Missouri Silver Pages Directory Publishing Corp., Inc. v. Southwestern Bell Media, Inc.*, 6 USPQ2d 1028, 1029 (TTAB 1988) (because applicant's motion to dismiss contains matter outside the pleading, it has been treated as a motion for summary judgment).

Moreover, a party may not file a motion for summary judgment until it has made its initial disclosures, unless the motion is based on issue or claim preclusion or lack of Board jurisdiction. *Qualcomm, Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010) (motion for summary judgment denied as premature where movant had yet to serve initial disclosures).

Treatment of a motion to dismiss under Fed. R. Civ. P. 12(b)(6) as a motion for summary judgment generally would result in a premature motion for summary judgment. Accordingly, when a motion for summary judgment would be premature, the Board will not consider a motion to dismiss including matter outside the pleading to be a motion for summary judgment. TBMP § 503.04.

In the instant case, Registrant has contested Petitioner's claim of abandonment simply by filing a *Motion to Dismiss* relying upon evidence in the form of a *Certification* which allege facts outside of the pleadings in support of said motion. *See Motion to Dismiss*. By relying upon

evidence outside of the pleadings Registrant's *Motion to Dismiss* is, in reality, a Motion for Summary Judgment as it pleads facts and relies upon evidence in support of its requested relief that are outside of the pleadings in this matter.

As such, Petitioner respectfully requests that the Board treat the instant *Motion to Dismiss* as a *Motion for Summary Judgment*.

Additionally, however, it is well settled that a party may not file a motion for summary judgment until it has made its initial disclosures. *Qualcomm, Inc.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010). As the Registrant has made no such disclosures it is respectfully submitted to the Board that the instant *Motion to Dismiss* is, rather, a premature Motion for Summary Judgment and, accordingly, should be denied.

In the alternative, should the Board choose to entertain the motion it is submitted that the parties to a proceeding are typically notified when a motion to dismiss is being treated as a motion for summary judgment, and the responding party will be given reasonable opportunity to present all material made pertinent to such a motion by Fed. R. Civ. P. 56. *See* Fed. R. Civ. P. 12(d); *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1044 (Fed. Cir. 1993) ("A movant's challenge to the sufficiency of the complaint as a matter of law, brought under 12(b)(6), is not sufficient notice that the non-movant must respond as if to a motion for summary judgment, and place material facts in dispute"). Should the Board decide to hear the instant motion it is respectfully requested that, consistent with *Advanced Cardiovascular Systems Inc.*, Petitioner be given time to respond to the motion as a motion for summary judgment once so concluded.

## **CONCLUSION**

WHEREFORE in consideration of the above Petitioner respectfully moves the Board for an order denying the Registrant's motion as a premature motion for summary judgment. In the alternative should the Board determine it will hear the same Petitioner respectfully moves the Board for notice of the same and to allow additional time for the Petitioner to respond to said dispositive motion.

Respectfully submitted this 31<sup>st</sup> day of July, 2013.

The Trademark Company, PLLC

/Matthew H. Swyers/

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Registrant.	:	

**Certificate of Service**

I HEREBY CERTIFY that a true and accurate copy of the foregoing pleading was served  
this 31<sup>st</sup> day of July, 2013 upon the following via first class mail:

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